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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,491	01/29/2001	Janne Kallio	59864 00527	7373
32294 7590 02/06/2009 SQUIRE, SANDERS & DEMPSEY L.L.P. 8000 TOWERS CRESCENT DRIVE 14TH FLOOR VIENNA, VA 22182-6212				
EXAMINER D AGOSTA, STEPHEN M				
ART UNIT 2617		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/770,491

Applicant(s)

KALLIO, JANNE

Examiner

Stephen M. D'Agosta

Art Unit

2617

Period for Reply -- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31, 32, 35-43, 45-52, 55, 56, 58-65, 67, 68, 70, 71, 73, 74 and 76-129 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 31-32, 35-43, 45-52, 55-56, 58-65, 67-68, 70-71, 73-74 and 76-129 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsman's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 31, 49, 55, 76 80, 81, 82, 85, 98, 106 (and their dependents), drawn to a process of identifying different networks (eg. scanning, registration and system selection), , classified in class 455, subclass 435.1 or 435.2.

- note that claims 49 and 81 do not fully identify a handoff.

- II. Claims (31 and 38 together), 42, 78, 90, 94, 114 and 120 (and their dependents), drawn to a handoff process, classified in class 455, subclass 436, 437 and 438 (eg. network or mobile initiated)

-- Group I only puts forth the concept of identifying different networks that can be performed for various reasons, eg. to build neighbor lists, etc.. There is NO explicit mention of a handoff.

-- Group II clearly and explicitly teaches a handoff operation being performed.

It is the examiner position that the sheer number of claims dictate a large burden on the examiner **to examine these two different concepts**. The applicant should either cancel one group of claims **OR** amend the claims such that only one inventive concept exists (eg. performing handoff based on the "similar structure" concept).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter.

1. **Claims 81, 85, 94, 106** defines a computer readable medium that should be "**embodied with**" a computer program (and cannot be a signal or wave).

The examiner upholds his USC 1010 rejection and is not swayed by the applicant's response. The applicant attempts to "explain away" that their computer readable medium concept and associated design would be easily contemplated, yet they have provided no explicit information in their specification to prove otherwise. The examiner must, when faced with no written information in the specification, conclude that there is no support for these claims and thus reject them.

2. **Claims 31, 36, 49, 82, 90 and 98** recite method steps that are not limited from only occurring in a computer processor (which is non-statutory). The applicant should amend these claims to identify how/where these methods are being performed.

3. **Claim(s) 49, 82, 90 and 98** is/are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, **a statutory "process" under 35 U.S.C 101 must (1) be tied to another statutory category (such as a particular apparatus), or transform(s) underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C 101").** The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's position is that a § 101 process must (1) be tied to another statutory class (a particular machine or apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to non-statutory subject matter.

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim ***should positively recite*** the other statutory class (the thing or product) to which it is tied, ***for example*** by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, ***for example*** by identifying the material that is being changed to a different state. (emphasis added)

- These claims do not explicitly state "what device" is performing the steps.

Claims

The applicant argues that **Claim 39 was not examined** and thus the previous office action was not complete.

1. Claim 39 states "*a receiver configured to receive information regarding a signal level of a serving cell and a neighbor cell*".

The examiner agrees that the claim was mistakenly omitted but notes that it is a minor omission for several reasons (eg. similar teachings can be found in other claims and these were properly rejected).

2. The concept of a mobile device containing a receiver to receive information from the network/cells is inherent in a mobile network. A mobile device receives, at a basic operational level, pilot/broadcast data from each proximate cell in order to determine which one to select as its "home cell" when said mobile is activated and registers.

3. Claim 31 clearly implies that the mobile device receives information from the network to identify and correlate which cells in the area belong to which network (eg. a first or second network). The prior art of record teaches this as well and this concept reads on the claim of receiving a signal of serving/nearby cells..

4. Claim 36 clearly implies that the mobile receives data from a/the cell(s) regarding frequency, BTS-ID, location, etc.. The prior art teaches this as well and this concept reads on the claim of receiving a signal of serving/nearby cells.

5. A mobile device inherently builds Neighbor Lists while roaming which requires the reception of signals from both the serving and neighboring cells for comparison such that the mobile can make handoff decisions.

6. The examiner notes that (at least) claims 43 and 56 teach the same/exact concept and the examiner erred in not including claim 39 with this group. One skilled understands this and the applicant's remarks are considered as pointing out a minor omission. *Note: had this claim been considered a pivotal inventive concept not found in any of the other claims, the examiner would have accepted this omission and put forth a new rejection.*

Claim Rejections - 35 USC § 112 (First Paragraph)

The following is a quotation of the ***first paragraph*** of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 81, 85, 94, 106 rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The disclosure of a computer program critical or essential to the practice of the invention, but included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The examiner finds no evidence/support in the specification (or figures) that a computer program was contemplated.

Claim Rejections - 35 USC § 112 (Second Paragraph)

The following is a quotation of the ***second paragraph*** of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 31, 36, 49, 82, 90 and 98 rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

While these claims are “method” claims, the examiner notes that they do not recite “what device” is performing the method. These claims merely recite that steps occur but do not recite where and thus they simply read on a computer program **manipulating data** (eg. the method steps as written can be performed in a computer processor and thus are not compliant).

Response to Arguments

Applicant's arguments filed 12-5-2008 have been fully considered but they are not persuasive.

1. The examiner notes that he has put forth a **restriction** to keep the invention clearly focused on one concept (which is not the case) and asks the applicant to either elect one of the two groups OR amend the claims to all recite a singular inventive concept (eg. storing of parameters used for handoff such that a similar cell structure is used).

2. The examiner is replying with ONLY the USC 101 and 112 issues since he believes that these need to be fixed. He also notes that many of the added/new claims have these same issues and should be fixed when a response is transmitted.

3. The examiner has also added (eg. pointed out) that several new USC 101 issues exist, pertaining to the John Love memo, with regard to method claims that do not specifically teach "what apparatus" is performing the steps identified. Claims 49, 82, 90 and 98 all teach a method but do not empirically identify "what" is performing the steps. These should be corrected.

4. The examiner has upheld his USC 112 first and second rejections since the applicant has not correct these problems:

- a. Certain claims only recite a computer manipulation of data.
- b. There is no support for computer readable medium designs found in the specification.

5. The previous prior art is still of record and the examiner can/may go FINAL in the next office action should the claims continue to teach the same inventive concepts.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen M. D'Agosta whose telephone number is 571-272-7862. The examiner can normally be reached on M-F, 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne Bost can be reached on 571-272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Stephen M. D'Agosta/
Primary Examiner, Art Unit 2617